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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,344	01/20/2006	Ian Lawrence	LAWRENCE-1 PCT	2149
25889	7590	04/27/2010	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			HOOK, JAMES F	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,344	Applicant(s) LAWRENCE, IAN	
	Examiner James F. Hook	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-31 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed January 4, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: having “only two webs” when the original specification was not limited to only two webs is considered new matter, where the inclusion of only creates new matter when the specification previously was not specific enough on the fact that only two webs could ever be used.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-31 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 22 recites “only two webs” where the original specification as filed did not provide support for the term “only” when such did not limit the webs to excluding all other possibilities, especially when there are

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other embodiments in the application, and without previously setting forth that only two webs were ever conceived, such is new matter with regards to the original specification.

Election/Restrictions

This application contains claims 33 and 34 drawn to an invention nonelected with traverse in the reply filed on August 3, 2009. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

It is noted that claims 33 and 34 are specific to an embodiment of a spiral shaped member and due to the fact that claim 22 is no longer generic to both embodiments, these claims can no longer be rejoined to the application at time of allowance and should therefore be canceled in any subsequent response.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-25, 29, 31, and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adair. The reference to Adair discloses the recited pipe for carrying gas and/or fluid comprising a supporting body 12 formed of a rigid plastic having multiple recesses as seen in the figures which

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pass through the body and allow such to be flexible yet resist compressive forces during use of the pipe, a thin membrane 14 of various different plastics is integrally provided on the supporting body, the membrane is on the outside, inherently the tube has ends of some sort, the membrane is form fitting in that it is seen to fit over the body with no gap, it is considered that the injection molding steps of claim 24 are not limiting to the article claim in that method steps hold no patentable weight on article claims, the recesses are distributed along the pipe such that it can flex in two directions due to there being only two webs connecting adjacent rings of the body, the membrane is in one piece as is the supporting body, such is a suction pipe in that tubes 74,78 can be used for irrigation and 80 used for biopsy which suggest some suction is present in one of the tubes, since the structure of the supporting body is shaped similarly to applicants it is considered to be cardanically flexible in that such is designed to bend on two different planes, the supporting body forms ring sections which are seen to be offset by 90 degrees with respect to others, and the membrane is airtight and tightly seals the recesses, where inherently the membrane would have to be either gas permeable or impermeable to air which is a gas, therefore inherently the material would be one or the other. It is believed that the material making up the outer membrane is inherently soft in that it is flexible, however, should it be argued that such is not the case, then it would have been obvious to one skilled in the art to modify the material of the outer membrane to be of a soft material as such would only require routine experimentation to arrive at optimum materials to use as such is merely a choice of mechanical expedients to make such of softer material where such would be desired since the apparatus is intended on being

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used inside of the body and a softer outer material would be more comfortable for the patient.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-29, 31, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Scarazzo and Balazs. The reference to Kahn discloses the recited pipe for carrying gas and/or fluid where the use of such with an internal combustion engine is merely intended use where the hose of Kahn is capable of used with a combustion engine in some form, comprising a supporting body 13 formed of a rigid plastic having multiple recesses as seen in the figures which pass through the body and inherently allow such to be flexible yet resist compressive forces during use of the pipe, a thin membrane 22 of various different plastics is integrally molded to the supporting body, the membrane is on the outside, inherently the tube has ends of some sort, the membrane is form fitting, it is consider that the injection molding steps of claim 24 are not limiting to the article claim in that method steps hold no patentable weight on article claims, the recesses are distributed along the pipe such that it can flex in two or more directions inherently, the membrane is in one piece as is the supporting body, such is a suction pipe, since they structure of the supporting body is shaped similarly to

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applicants it is considered to be cardanically flexible, the supporting body forms ring sections which are seen to be offset and at least some are offset 90 degrees with respect to others, and the membrane is airtight and tightly seals the recesses. The reference to Kahn discloses all of the recited structure with the exception of providing the ends with connection portions which can be formed of a second material, using only two webs connected to adjacent turns offset by 90 degrees, and forming an outer gasket of a second material. The reference to Scarazzo discloses that it is old and well known in the art to provide flexible tubes with connections at the ends to connect to other things where an insert of a second material can be used and formed in such a way that the material forms a gasket outside of the membrane at 22 as well. It would have been obvious to one skilled in the art to modify Kahn by providing an insert of a second material in end connection sections of the tube and to provide such with an outer gasket of second material as suggested by Scarazzo where such would allow for the tube to be connected to a suction source and more positively seal the connection thereby insuring proper functioning of the hose. The reference to Balazs discloses that it is old and well known in the art to form articulated tubes with various slots cut into a rigid structure to allow for bending in various different planes, and including one embodiment seen in figure 3a which has only two webs offset by 90 degrees to create a cardanically flexible structure about a tube formed by lumen 53 and the material surrounding it and the webs 33 extending from it, where slots 13a,b form rings and webs, where such can be used for medical suction applications. It would have been obvious to one skilled in the art to modify the supporting body of Kahn by substituting a

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structure that has two webs only and are offset by 90 degrees as suggested by Balazs where such is shown to be an equivalent structure to a spirally formed sleeve and would set forth a specific bending direction between two different directions for applications that require more limited bending directions.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Scarazzo and Balazs as applied to claims 22-29, 31, and 35 above, and further in view of Yamamura. The reference to Kahn as modified discloses all of the recited structure with the exception of using the hose for suction in an engine. The reference to Yamamura discloses that it is old and well known in the art to use corrugated hoses with connection ends for suction lines and that such can be attached to an engine. It would have been obvious to one skilled in the art to modify Kahn as modified to be capable of use with a combustion engine as suggested by Yamamura where such would improve the usefulness of the tube when such is a known tube for use with suction.

Claims 22-25, 29, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balazs in view of Adair. The reference to Balazs discloses all of the recited structure with the exception of providing an outer soft membrane. It would have been obvious to one skilled in the art to provide the supporting body of Balazs with an outer membrane as suggested by Adair where such would protect the body from getting material stuck in the slots during use thereby making it easier to clean.

Response to Arguments

Applicant's arguments with respect to claims 22-31 and 35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/
Primary Examiner, Art Unit 3754

JFH